

REMARKS

Claims 28-36, submitted hereby in place of original claims 1, 2, 14, and 15, are pending. Claims 3-13 and 16-27 stand withdrawn pursuant to a restriction requirement.

Present claim 28 represents subject matter of original claim 1, revised with respect to the recited "variants" in accordance with disclosure found at page 4 of the present specification, as explained further, below. Present claim 29 represents subject matter of original claim 2, recited in a manner to more clearly define the invention and, thus, overcome the rejection of record under section 112, paragraph 2, as explained below. Present claims 30 and 31 represent subject matter in original claims 14 and 15, respectively. Present claims 32-36 limit present claim 28 to subject matter in claim 29 recited in the alternative.

Applicants wish to thank Examiner Patrick Nolan for the courteous consideration rendered to their representative during an interview at the PTO on April 3, 2002. Each of the rejections of record was discussed during the interview. The instant paper is submitted pursuant to those discussions.

With respect to the rejection of claim 2 under section 112, paragraph 2, Applicants submit that replacement claim 29, which was discussed with the Examiner during the interview, overcomes the rejection.

Claims 1, 2, 14, and 15 were rejected under 35 USC 112, ¶1, for allegedly failing to satisfy the written description requirement with respect to the recited "variants." Reconsideration is requested.

The meaning of "variants" provided in the present specification (page 4) satisfies the written description requirement of § 112, ¶ 1. In order to more clearly define "variants," replacement claim 28 incorporates language from the specification definition. More precisely, the limitation as to activity of the "variants" is changed from "variants . . . which correspond to eukaryotic neutral sphingomyelinase in terms of biological or immunological activity" to --a variant . . . having eukaryotic neutral sphingomyelinase enzymatic activity--; and, the variations subsumed within "variant" are recited as:

- a naturally occurring allelic variation of SEQ ID NO: 1 or SEQ ID NO: 2,
- SEQ ID NO: 1 or SEQ ID NO: 2 having one inserted, deleted, or conservatively substituted amino acid,
- N-terminally truncated or C-terminally truncated SEQ ID NO: 1 or SEQ ID NO: 2, or
- acetylated, glycosylated, amidated, and/or phosphorylated SEQ ID NO: 1 or SEQ ID NO: 2.

According to the Office Action, claim 2 is free of the prior art. Therefore, claim 29, presented hereby, which replaces claim 2, is also free of the prior art.

Claims 1, 14, and 15 were rejected under 35 USC 103(b) based on Chatterjee. Reconsideration is requested.

For anticipation under § 102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). The absence from a prior art reference of a single claim limitation negates anticipation. *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81 (Fed. Cir. 1986). A reference that discloses "substantially the same invention" is not an anticipation. *Jamesbury Corp.* To anticipate the claim, each claim limitation must "*identically appear*" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis added*). To be novelty defeating, a reference must put the public in possession of the identical invention claimed. *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985).

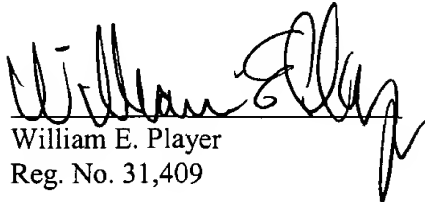
Applicants submit, herewith, an *alignment* of the sequence of amino acids representing the presently claimed invention with the sequence of amino acids disclosed in Chatterjee. As readily appreciated from the alignment, the sequence in Chatterjee is not identical to the presently claimed sequence. Accordingly, there is no anticipation of the rejected claims, or the present replacement claims, by Chatterjee. *Gechter, supra. Donahue, supra.*

Favorable action is requested.

Respectfully submitted,

JACOBSON·HOLMAN PLLC

By:



William E. Player
Reg. No. 31,409

400 Seventh Street, N.W.
Washington, D.C. 20004
Tel. No.: 202-638-6666
Atty. Dkt. No. P61950US1
Date: May 20, 2002
R:\rthomas\2002\May\AP61950US1amd.wpd